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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appn. Number 09/872,914
 Appn. Filed 06/01/2001
 Applicant Ferdinand Schermel
 Title Tilttable Modular Recycle Container System
 Examiner Stephen J. Costellano
 Art Unit 3727

FAX RECEIVED

FEB 03 2003

GROUP 3700

Attention: Lee W. Young, Supervisor
 Washington, D.C. 20231

Feb. 3 /2003

No. of pages including this one: 4 and 1 page of drawing

Re: Applicant requests supervisory review of examiner's position of the applicants filing of the RCE not being proper.

Sir:

The applicant respectfully requests a supervisory review as applicant and examiner have been unable to proceed further. Applicant has presented clear and specific arguments but has not received specific responses and, in some instances, any response to arguments. The applicant realizes his limited understanding of the process and rules and reluctantly asks again for supervisory review of the examiner's response and position, as an appropriate next step.

The applicant has outlined how MPEP 806.04 (f, h, e.), and has also added (b) in this paper, prove that the claims of the RCE pertain to the elected invention. Applicant has submitted detailed arguments of how the tests of the MPEP rules support that : claims 1 and 2 are not mutually exclusive, that they are not patentably distinct and unpatentable over each other, that there is no distinction between species, and the claims have a commonality of operation, function and effect. These prove that the restriction requirement cannot be sustained and that the claims submitted are the elected invention, making the RCE fully responsive and proper.

Since the examiner will not respond to the arguments of how the claims are supported by all of the MPEP rules, rendering proof that there is no distinction of "another specie", but insists that they are directed to "another specie", the applicant respectfully requests that the examiner or supervisor defines the other species in reference to the claims and MPEP rules.

Since the examiner remains unconvinced that the language "at least one attachable container" does not include two nor a plurality of attachable containers, nor responds to the question of this language, applicant respectfully requests that the supervisor would either convince the examiner that at least one includes two, or if in agreement with the examiner, provide an explanation why it does not.

Applicant also requests reference to the MPEP rule or other rule that would not allow the claimed priority to the provisional patent, which shows a wheeled container with two attachable containers (PET page 5 of 5), to support and demonstrate reduction to practice of the configuration in question, as well as not being new matter.

Applicant requests that future communication be faxed as soon as possible as well as mailed to respect the demand of paper NO. 14 that all future communication be in writing, but still allow communication to proceed quickly.

PET Page 1 of 5

applicant admits
 states there
 is no distinction
 between species

In response to the PAPER NO. 17 Office Action mailed 11/05/2002, concerning claim 2 and the combining into claim 1 new matter. Applicant has sent with the RCE a drawing of wheeled container with two attachable containers, one attachable container secured to the top of the first attachable container. This drawing is page 6 of 14 of the provisional patent filed on 06/08/2000 application no. 60/209,964 as pursuant to 35 U.S.C. 119(e)(i) priority claimed in the Patent Application Transmittal Letter, and is identical in concept and structure to the amended fig. 1, showing one wheeled container and two attachable containers. This fig of the provisional patent should positively confirm that the art is not new matter to this application and that a wheeled container with two attachable containers stacked on top of the wheeled container is the art reduced to practice as of 06/08/2000. The original fig. 1 illustrated the forming of the rigid entity (also mentioned in claim 11) for rolling in the tilted position showing the simplest configuration of the invention. The forming of the rigid entity has been the subject matter of the elected specie and is addressed by the claim language in claim 1 and is considered the object of the invention and elected specie. Claim 11 states "at least one attachable container, and a means for securing adjoining said wheeled container to said attachable container whereby the combined containers form a single rigid entity". Claim 2 adds duplication of the said attachable container and means for securing, and should be considered duplication of existing matter and procedure of claim 1, but not new matter. Claim 2 is primarily relied upon to narrow the attached location of the attachable containers to being on top of the first said attachable container, as well as their structural configuration relative to each other as being stacked (or piled).

Even if claim 2 were considered canceled, the phrase "at least one" in reference to the attachable container of claim 1, clearly claims one as well as two attachable containers, as the amended fig 1 illustrates, or three or a plurality of attachable containers. Claim 1 then can by itself support the claim language of claim 2 when claim 1 includes more than one attachable container to be attached. Applicant relies on claim 1 language to support the fig 1 amendment and two attachable containers.

It is unclear to the applicant what is meant by the "claim language contained in claim 2 of Amendment B filed Sept. 12, 2002 as paper No. 10" as this proposed amendment was not allowed and not entered. Claim 2 has not been amended since it's original filing date. For the above reasons the applicant requests the allowance of the fig 1 amendment and the claim 2 language in the RCE.

1. A modular wheeled container system that is tilted from the free standing position for rolling comprising:
 - a) a wheeled container having a means for rolling
 - b) at least one attachable container, and
 - c) a means for securing adjoining said wheeled container to said attachable container.
2. The system of claim 1 further including a plurality of attachable containers stacked and secured on top of said attachable container.

Applicant respectfully requests clarification on following if the RCE is still not considered properly filed:
a) why the proposed but "not allowed" amendment of Amendment B filed Sept. 12, 2002 as paper No. 10 is referred to, or relevant

- b) a description of the elected subject matter and it's associated issues
- c) a description of the non-elected subject matter and it's associated issues
- d) a description of the new matter and how and why it is considered new matter
- e) how and why the provisional patent figure sent with the RCE is not considered relevant as the art reduced to practice
- f) and how and why the new matter is not claimed by the claim 1 language "at least one attachable container" and how the language does not include two, or a plurality of attachable containers
- g) what specific changes would have to be made in the RCE to make it proper

PET Page 2 of 5

Applicant has responded to PAPER NO. 17 Office Action mailed 11/05/2002, concerning the improper filing of the RCE with regards to claim 2 and the combining into claim 1 new matter. The issue at this time is that claim 2 is directed to non-elected subject matter. Applicant would respectfully add to the omission or correction submitted Nov. 23, 2002, the following considerations to support that claim 2 is part of the elected invention:

With regards to MPEP 806.04(f). "Claims restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that when one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species". In this patent "at least one attachable container" includes "a plurality of attachable containers" and therefore claims 1 and 2 are not mutually exclusive and cannot be restricted to different species.

With regards to MPEP 806.04(h) the species must be patentably distinct from each other. Restriction should not be required if the species claimed are considered clearly unpatentable over each other. The forming of a rigid entity is the issue pertaining to the elected species. Suppose a configuration of a wheeled container having three attachable containers as claimed in claim 1 ("at least one attachable container", but in this instance three attachable containers). Such a configuration would be identical to the configuration described or claimed by claim 2 where in this instant case a plurality of two attachable containers is selected. Both configurations would have a wheeled container with three attachable containers. Both claim 1 and 2 in this instance would be clearly unpatentable over each other.

With regards to MPEP 806.04(e) claim 1 and 2 have a commonality of operation, function and effect in that they both form the rigid entity and are both secured in the same manner.

With regards to MPEP 806.04(b) for "at least one attached container" and "a plurality of attached containers" (secured to said wheeled container) are not independent and in order to sustain a restriction requirement, distinction must be shown. Distinction is proven if it can be shown that the intermediate product is useful other than to make the final product. The wheeled container with at least one attached container secured at their adjoining interface produces the final product of a rigid entity that can be tilted for rolling. Similarly, a wheeled container with a plurality of containers secured at their adjoining interface produces the final product of a rigid entity that can be tilted for rolling. The forming of the rigid entity by securing adjoining containers is the object, function, and final product of the invention. The examiner has not given an example of an alternate use to prove distinctness therefore the restriction of claim 2 cannot be sustained if there is no independent species.

The examiner has stated that *Claim 1 now requires a stack of three containers wherein the bottom container is a wheeled container, this was never claimed*. Claim 1 originally states

- a) a wheeled container having a means for rolling
- b) at least one attachable container,

The applicant again asks why at least one attachable container does not include two attachable containers?

The examiner then states *claim 1 now claims something different than the original claims and not covered by any of the original drawings and seems properly restrictable by original presentation as being directed to another specie, then claim 1 should not be examined in this RCE*.

Claim 1 is a functional recitation claiming the securing of adjoining containers to form a rigid entity which is illustrated by Fig 1 and the amended Fig 1. This functional recitation determines the specie. The structural components of 1, 2, 3, 4 or more attachable containers are not what determines the specie. The examiner has stated that it *seems properly restrictable by original presentation* but does not refer to any rules or laws, nor does the examiner respond to the rules of MPEP 806.4 (f), (h), (e) that applicant cites that determine whether the restriction to the election is proper as submitted in applicants Dec. 12, 2002 fax.

The examiner also does not respond to questions a) to e) on page 2 of the Nov. 23, 2002 fax or state the rules that would make a provisional patent unreliable for art or reduction to practice.

The wheeled container with two attachable containers as shown in the amended Fig 1 is significant in obviating the invention over the prior art of Evans by demonstrating the novelty of "securing adjoining containers" unlike Evans' binding containers onto a cart. Applicant's claim is the functional claim of forming a rigid entity by means of securing between adjoining containers which requires a minimum of one wheeled container and at least one attachable container.

For the above reasons as well as those the Nov. 23, 2002 response, the applicant requests the allowance of the fig 1 amendment and the claim 2 language in the RCE.

Since the communication is limited to written only (paper No. 14) applicant requests that further communication is faxed as soon as possible as well as mailed.

The time period for response is not clear due to the terms used in the communication from the examiner. Applicant has requested clarification in his Dec. 6/02 fax to the examiner that was never responded to. The examiner will not fax communication prior to mailing as repeatedly requested by applicant, and since phone conversation are not allowed as stated in the interview summary filed Sept. 26, 2002 as paper No. 14. This causes delay in response since the date at which the communication arrives at applicant's home is 3 weeks after the "Date Mailed". When a one month response is demanded, applicant pro se must first study the MPEP etc., and then respond. Situations such as the time periods and ramifications for not properly responding to an RCE are not clear and applicant receives conflicting information from various experienced resources, such as retired examiners at the Inventors Assistance Center.

Applicant pro se

PET Page 4 of 5



Ferdinand Schermel